

C. APPLICANT'S COMMENTS

Claims 1, 10, 11, 13 are pending in this Application, with Claims 2-9, 12, 14-20 canceled and Claims 21-23 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1, 10, 11, 13 and favorable consideration of Claims 21-23 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The Applicant has amended the Specification to modify the status of the prior application.

Paragraph 2 of the Office Action

The Official Action rejected as-filed Claims 1-3, 12, 19 under 35 U.S.C. §102(e) as being anticipated by Ellis (U.S. Patent No. 6,957,791). The Applicant respectfully disagrees with this rejection for at least the following reasons.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under 35 U.S.C. §102, anticipation requires that the prior art reference both (1) disclose, either expressly or under the principles of inherency, every limitation of the claim, and (2) be enabling thus placing the allegedly disclosed matter in the possession of the public.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ "The identical invention must be shown in as complete detail as is contained in the ... claim."² Hence, under 35 U.S.C. §102, anticipation requires that **each and every element** of the claimed invention be disclosed in the prior art.³ Anticipation also requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.⁴ In addition, the prior

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

³ *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁴ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.⁵

Independent Claim 1 has the following features:

1. (Currently Amended) A toilet plunger cabinet system for storing a plunger, comprising:
a base having a lower plate and an extended portion extending upwardly from an upper surface of said lower plate defining a lower cavity for receiving a suction cup of said plunger;
wherein said base includes a support portion within said upper surface of said lower plate;
wherein said support portion has an X-shaped structure;
wherein said extended portion has an elongate tubular structure with an upper opening;
wherein said lower plate has a flat structure;
a strap member attached to said base;
a cover removably attachable about said extended portion of said base;
a hinge pivotally connected between said cover and said extended portion for pivotally supporting said cover;
wherein said cover is comprised of an elongate tubular structure;
wherein said cover has an upper end, a body portion and an open lower end;
wherein said upper end is enclosed;
wherein said body portion has a circular cross section;
wherein said cover has a lower lip that fits within said upper opening of said extended portion of said base;
a handle member attached to said upper end of said cover;
wherein said handle member has a spherical shape; and
a toilet plunger positioned within said base and completely surrounded by said base.

It is respectfully submitted that Ellis does not contain all of these features, such as but not limited to:

- wherein said base includes a support portion within said upper surface of said lower plate;
- wherein said support portion has an X-shaped structure;
- a strap member attached to said base;
- a cover removably attachable about said extended portion of said base;

⁵ *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) (emphasis added).

- a hinge pivotally connected between said cover and said extended portion for pivotally supporting said cover;
- wherein said cover is comprised of an elongate tubular structure;
- wherein said cover has an upper end, a body portion and an open lower end;
- wherein said upper end is enclosed;
- wherein said body portion has a circular cross section;
- wherein said cover has a lower lip that fits within said upper opening of said extended portion of said base; and
- a handle member attached to said upper end of said cover;
- wherein said handle member has a spherical shape; or
- a toilet plunger positioned within said base and completely surrounded by said base.

In addition, if a device was “known or used by others” in this country before the date of invention or if it was “in public use” in this country more than one year before the date of application, it qualifies as prior art. *See* 35 U.S.C. § 102(a) and (b). “Generally, the party who establishes that he is the *first to conceive* and the *first to reduce* an invention to practice is entitled to a patent thereon.” Lutzker v. Plet, 843 F.2d 1364, 6 USPQ2d 1370 (Fed. Cir. 1988). “Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.” Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986).

37 C.F.R. §1.131 allows an applicant to “swear behind” a prior art reference by submitting an oath or declaration alleging facts that “establish a completion of the *invention in this country* before the effective date of the prior art.” In re Gosteli, 872 F.2d 1008, 1011-12, 10 USPQ 2d 1614, 1617 (Fed. Cir. 1989). After an applicant has effectively sworn behind a prior art reference, the prior art reference is thereby *removed from consideration*. In re Land, 368 F.2d 866, 151 USPQ 621, 632 (C.C.P.A. 1966) (“reference’ can be overcome . . . by ‘swearing back’ of it under Rule 131”). Rule 131 applies to rejections based upon 35 U.S.C. §102(a) or (e), or 35 U.S.C. §103. 37 C.F.R. §131 (1998). In addition to the above arguments, the Applicant respectfully submits the attached Declaration of Michael S. Neustel showing a conception date coupled with diligence prior to the filing date of the Ellis patent (U.S. Patent No. 6,957,791).

The Applicant respectfully submits that Ellis does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Ellis does not disclose (expressly or inherently) all of the features of independent Claims 1 and 21. Therefore, Applicant respectfully submits that independent Claims 1 and 21 are patentable over the cited reference for at least these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding rejection as applied to independent Claim 1, since the application is in condition for allowance.

Paragraph 3 of the Office Action

The Official Action rejected Claims 1-20 under 35 U.S.C. §103(a). It appears that Claim 16 was not rejected but for the purposes of this response it will be assumed this is included since Claim 6 was also rejected which has the same features but not in combination with Claim 12 (which the applicant respectfully reserves the right to argue the same). The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

i. Burden on Examiner to Establish Prima Facie Case

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.⁶ When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.⁷ “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”⁸

“To establish a *prima facie* case of obviousness, three basic criteria must be met.”⁹ First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

⁶ *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

⁷ *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁸ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

⁹ MPEP §706.02(j).

combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹⁰

ii. Legal Requirements for Obviousness

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.”¹¹ “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art.”¹² “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention**, the **subject matter of the references**, the extent to which they are **in the same or related fields of technology**, the **nature of the advance** made by the applicant, and the **maturity and congestion of the field**.”¹³ Obviousness requires proof “that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed.”¹⁴

¹⁰ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹¹ *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

¹² *Id.*

¹³ *Id.*

¹⁴ *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Derwent ACC-NO 2003-619649 teaches a carrying case for holding a "recreational kite". First, this reference is non-analogous to the present invention since it is solving the problem of carrying a kite and not for carrying a toilet plunger. It is **not within the field of the inventor's endeavor** and is **not reasonably pertinent to the particular problem with which the inventor**

was involved. Hence, the Derwent ACC-NO 2003-619649 should not be included as a reference against the present invention.

The Ellis reference does not teach all of the features of the present invention as discussed above and has been sworn behind by the Applicant. The Kent reference does not apply since it does not teach “a toilet plunger positioned within said base and completely surrounded by said base.” In fact, none of the references cite a toilet plunger completely surrounded within a base.

For these reasons, among others, the combination of the prior art references cannot suggest the combination of features in applicant’s claims, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and the claims allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner’s Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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